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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/754,487

01/09/2004

Larry W. Gatlin

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6181

7590 12/27/2006
ROBERT W. STROZIER
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EXAMINER

BOYER, RANDY

ART UNIT

PAPER NUMBER

1764

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/27/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/754,487

Applicant(s)

GATLIN, LARRY W.

Examiner

Randy Boyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 36-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :15 November 2005 and 1 November 2006.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-35, drawn to a method for using a sulfur scavenging composition, classified in class 208, subclass 236.
 - II. Claims 36-59, drawn to a sulfur scavenging composition and method for making a sulfur scavenging composition, classified in class 507, subclass 239.
2. The inventions are independent or distinct, each from the other because: Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the composition of (or prepared by) the Group II invention could be used for treating fluids other than in a well or well bore environment and/or possesses utility in applications other than the removal of noxious sulfur species, e.g. as a corrosion inhibitor or additive in a cleaning formulation.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Robert W. Strozier, attorney for Applicant, on December 13, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 36-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Duplicate Claims, Warning

5. Applicant is advised that should claim 1 be found allowable, claim 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Weers (EP 475641 A1).

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8. With respect to claims 1 and 18, Weers discloses contacting a hydrocarbon containing hydrogen sulfide with an effective amount of a sulfur scavenging composition comprising substantially monomeric aldehyde-amine adducts (see Weers, page 2, lines 48-50).

9. With respect to claims 2-6, 19, and 23-26, Weers discloses the use of aldehyde and amine species to produce a sulfur scavenging composition (see Weers, pages 3-5).

10. With respect to claims 7 and 27 and Weers discloses a sulfur scavenging composition comprising a solution including from about 5 wt.% to about 50 wt.% of the adducts, the remainder being a solvent (see Weers, page 5, lines 57-58).

11. With respect to claims 8-17 and 20-22, Weers discloses contacting a sulfur scavenging composition with a hydrocarbon containing hydrogen sulfide (see Weers, page 5, lines 53-54).

12. With respect to claims 28 and 29, Weers provides an inherent disclosure for contacting a sulfur scavenging composition *in a container*. Weers does not explicitly disclose use of a "container." Nevertheless, the person having ordinary skill in the art would recognize from Weers' disclosure that use of some sort of container is necessary to hold the sulfur-containing hydrocarbon to be treated by the sulfur scavenging composition. Likewise, the person having ordinary skill in the art would recognize that the sulfur scavenging composition could be added (or "contacted") with the hydrocarbon either prior to, after, or at the same time as adding the hydrocarbon to the "container."

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13. With respect to claim 30, Weers discloses a sulfur scavenging composition comprising a solution including from about 5 wt.% to about 50 wt.% of the adducts, the remainder being a solvent (see Weers, page 5, lines 57-58).

14. With respect to claim 31, Weers discloses contacting a sulfur scavenging composition with a hydrocarbon containing hydrogen sulfide (see Weers, page 5, lines 53-54).

15. With respect to claims 32-34, Weers provides an inherent disclosure for introduction of a sulfur scavenging composition via a chemical tool, coiled tubing, or capillary coiled tubing (CCT). Weers does not provide an explicit disclosure for the means by which the sulfur scavenging composition is added to the sulfur-containing hydrocarbon to be treated. Nevertheless, the person having ordinary skill in the art would recognize that any suitable means could be used, be it by pouring (i.e. "batch introducing step"), by pumping the composition through a pipe, or other "chemical tool," "coiled tubing," or "capillary coiled tubing (CCT)."

16. With respect to claim 35, Weers discloses a sulfur scavenging composition comprising a solution including from about 5 wt.% to about 50 wt.% of the adducts, the remainder being a solvent (see Weers, page 5, lines 57-58).

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, 12-15, and 18-21 of Gatlin (US 7140433). Although the conflicting claims are not identical, they are not patentably

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distinct from each other because both claim the same methods of use for the same sulfur scavenging composition.

The invention of the '433 patent is claimed in terms of the chemical structural formula of a compound contained in the sulfur scavenging composition (see Gatlin, claim 1). The invention of the present application is claimed in terms of a composition comprising "substantially monomeric aldehyde-amine adducts" of a given set of chemical structural formulas. In view of the teachings disclosed in the '433 patent describing suitable amine and aldehyde species for producing the sulfur scavenging composition, the claims of the present application are not patentably distinct.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Boyer whose telephone number is (571) 272-7113. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola, can be reached at (571) 272-1444. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RPB

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke at the end.